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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,040	11/26/2003	Keith C. Hullfish	AOL0126	7812
22862	7590	03/14/2006	EXAMINER	
GLENN PATENT GROUP 3475 EDISON WAY, SUITE L MENLO PARK, CA 94025			BHATIA, AJAY M	
			ART UNIT	PAPER NUMBER
			2145	

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/723,040

Applicant(s)

HULLFISH ET AL.

Examiner

Ajay M. Bhatia

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/11/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the item 310 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

This is for drawings submitted 5/11/2004, which lake item 310 which was present in the original drawings.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

Art Unit: 2145

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 22, 42 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,12,15 of U.S. Patent No. 6,714,793. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the narrower claims in the Patent anticipates the broader claims of the current pending application.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Art Unit: 2145

Claims 1-61 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. The claim fail to produce according to all possible scenarios a "specific machine to produce a useful, concrete, and tangible result."

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-61 are rejected under 35 U.S.C. 102(b) as being anticipated by Mache et al. (U.S. Patent Application Publication 2001/003202).

For claim 1, Mache teaches, a method of transmitting electronic messages in a computer environment, comprising the steps of:

receiving an electronic message addressed to a telephone number;

(Mache, figures 4,5, paragraph 34, 73, 77)

determining an instant message identifier associated with the telephone number; (Mache, paragraph 53)

determining whether an instant message receiver is available to receive messages addressed to the instant message identifier; (Mache, paragraph 51)

forwarding the electronic message as an instant message addressed to the instant message identifier in response to a determination that an instant message receiver is available to receive instant messages addressed to the instant message identifier; (Mache, paragraphs 19, 57)

and sending the electronic message to a mobile device at the telephone number in response to a determination that no instant message receiver is available to receive instant messages addressed to the instant message identifier. (Mache, paragraphs 21, 57)

For claim 2, Mache teaches, wherein the electronic message comprises any of:  
a text message, an SMS text message, an MMS message, a video message, and an audio message. (Mache, paragraphs 3, 34)

For claim 3, Mache teaches, wherein the instant message is received at an electronic device configured to receive instant messages addressed to the instant message identifier. (Mache, paragraph 76)

For claim 4, Mache teaches, wherein the electronic device comprises any of:  
a computer, a personal data assistant (PDA), and a telephone receiver.  
(Mache, paragraph 104)

For claim 5, Mache teaches, wherein the determining the instant message identifier comprises searching for the instant message identifier associated with the telephone number in a database. (Mache, paragraphs 9, 49, 73)

For claim 6, Mache teaches, further comprising the step of:  
determining whether or not to forward the electronic message as an email message addressed to an email address according to a user preference stored in a database. (Mache, paragraph 57)

For claim 7, Mache teaches, further comprising the step of:  
determining whether or not to forward the electronic message as an instant message addressed to the instant message identifier according to a user preference stored in a database. (Mache, paragraphs 57, 67, 70)

For claim 8, Mache teaches, wherein the determining whether or not to forward is further based on source information of the electronic message. (Mache, paragraphs 73, 126, 141)

For claim 9, Mache teaches, wherein the source information comprises any of:  
a source address of the electronic message, a user name of a sender of the electronic message, a telephone number of a sender of the electronic message, and

Art Unit: 2145

an instant message identifier of a sender of the electronic message. (Mache, paragraph 73)

For claim 10, Mache teaches, wherein the instant message is generated from the electronic message based on one or more predetermined rules. (Mache, paragraphs 93, 141)

For claim 11, Mache teaches, wherein the one or more predetermined rules select one or more portions of the electronic message as the instant message. (Mache, paragraph 141)

For claim 12, Mache teaches, wherein the one or more predetermined rules selectively delete one or more portions of the electronic message to generate the instant message. (Mache, paragraph 65)

For claim 13, Mache teaches, further including the step of forwarding the electronic message to a storage medium. (Mache, paragraph 111)

For claim 14, Mache teaches, further including the step of storing the electronic message in the storage medium. (Mache, paragraph 111)

For claim 15, Mache teaches, further comprising the step of:



determining whether or not to forward the electronic message to the storage medium according to the user preference stored in the database. (Mache, paragraph 57)

For claim 16, Mache teaches, further comprising the step of:  
forwarding the electronic message to the storage medium when the forwarding to the mail address and the instant message identifier fails (Mache, paragraph 93)

For claim 17, Mache teaches, wherein the determining whether or not to forward is further based on source information of the electronic message. (Mache, paragraph 87, 143)

For claim 18, Mache teaches, the method of claim 15, wherein the user preference stored in the database includes date and time preference of the instant message receiver. (Mache, paragraph 83)

For claim 19, Mache teaches, the method of claim 1, further includes the step of logging the forwarding the electronic message. (Mache, paragraph 93)

For claim 20, Mache teaches, the method of claim 1, further includes blocking the forwarding of the electronic messages based on a list of telephone numbers. (Mache, paragraph 131)

For claim 21, Mache teaches, the method of claim 1, wherein the forwarding is based on the one or more predetermined rules. (Mache, paragraph 93)

Claims 22-61 list all the same elements of claims 1-21, but in system and medium form rather than method form. Therefore, the supporting rationale of the rejection to claims 1-22 applies equally as well to claims 22-61.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached UPSTO 892 (if appropriate).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajay M. Bhatia whose telephone number is (571)-272-3906. The examiner can normally be reached on M-F 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571)272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2145

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason Cardone  
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AB